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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,230	12/08/2000	Yoshifumi Tanimoto		1021
26021	7590	05/17/2007		
HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
			EXAMINER LETT, THOMAS J	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/733,230	<b>Applicant(s)</b> TANIMOTO, YOSHIFUMI	
	<b>Examiner</b> Thomas J. Lett	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 16 February 2007 have been fully considered but they are not persuasive. Applicant amends claims 1, 2 and 10 to clearly require that the facsimile machine is connectable to both a LAN and the internet, and not just to a LAN as asserted by the Action and disclosed by Ikeda. This is clearly new matter since Applicant did not disclose that the claimed facsimile machine 31 is connected to the internet. By Applicant's own disclosure, the claimed facsimile machine is connected to a LAN and a PSTN as shown in Figures 1 and 3. Notably in Figure 1, the facsimile machine 31 is only connected to PSTN 32 and LAN 34. In addition, when viewing Figure 3, no portion of facsimile machine 31 is connected to Internet 39. The specification does not mention facsimile machine 31 connected to the Internet 39. Applicant clearly discloses "The internet 39 is connected to LAN 34 via the router 38. To the internet 39, connected are an internet facsimile machine 40 and internet client machine 41" on page 9, lines 6-11. Applicant's own facsimile machine 31 is never connected to Internet 39. For these reasons, the final rejection is maintained and the Internet connection is not given patentable weight.
2. Ikeda clearly teaches of managing transfer requests in paragraphs 0046-0053 which reads on "accepts the request for data transfer if the e-mail is received over LAN".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-3, 5-8, 10-12 and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda (JP 408298509 A).

Regarding claim 1, Ikeda discloses a facsimile machine (facsimile apparatus 201, see Fig. 2) connectable to PSTN (PSTN 120) and another network (LAN 135) and adapted to receive data from a data transmitter (data from devices connected to LAN 135, see Fig. 2) over the another network and transfer the data to a recipient, comprising:

a memory (RAM 103) for storing delivery conditions (communication management information, para. 0036), including whether or not a request for data transfer should be accepted, in accordance with at least part of an address of a data transmitter (communication links, para. 0036); and

a control unit (CPU 101 controlling entire facsimile apparatus 201, para. 0010) for determining whether the request for data transfer should be accepted, based on the address (para. 0038 and para. 0048) of the data transmitter and the delivery conditions (communication management information, para. 0036), wherein the another network includes LAN and internet (see Fig. 2), the data is an e-mail (para. 0003), and the control unit accepts the request for data transfer if the e-mail is received over LAN and does not accept the request for data transfer if the e-mail is received over the internet (determined based on communication management information, para. 0036), wherein when the control unit does not accept the request for data transfer, the request for data transfer is printed (management report is printed when data cannot be managed, para. 0070).

Regarding claim 2, Ikeda discloses a facsimile machine (facsimile apparatus 201, see Fig. 2) connectable to PSTN (PSTN 120) and another network (LAN 135) and adapted to receive data from a data transmitter (data from devices connected to LAN 135, see Fig. 2) over the another network and transfer the data to a recipient comprising:

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a memory (RAM 103) for storing delivery conditions (communication management information, para. 0036) including recipients registered in accordance with at least part of an address of a data transmitter; and

a control unit (CPU 101 controlling entire facsimile apparatus 201, para. 0010) for determining a recipient of data, based on the address (para. 0038) of the data transmitter (para. 0039 and para. 0048) and the delivery conditions (communication management information, para. 0036), and transferring the data to the determined recipient, wherein the another network includes LAN and internet (see Fig. 2), the data is an e-mail (para. 0003), and the control unit accepts the request for data transfer if the e-mail is received over LAN and does not accept the request for data transfer if the e-mail is received over the internet (determined based on communication management information, para. 0036), wherein when the control unit does not accept the request for data transfer, the request for data transfer is printed (management report is printed when data cannot be managed, para. 0070).

Regarding claim 3, Ikeda discloses a facsimile machine of claim 2, wherein the delivery conditions include day and time of data transfer (see at least para. 0046).

Regarding claim 5, Ikeda discloses a facsimile machine of claim 2, wherein the recipient is specified by a facsimile number (para. 0038) or e-mail address.

Regarding claim 6, Ikeda discloses a facsimile machine of claim 2, wherein the controller can transfer the data to a plurality of recipients (see Fig. 7).

Regarding claim 7, Ikeda discloses a facsimile machine of claim 6, wherein the recipients are specified by facsimile numbers and e-mail addresses (para. 0003, Fig. 3, and Fig. 7).

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Regarding claim 8, Ikeda discloses a facsimile machine of claim 2, wherein the recipients include a printer (printer 206, see Fig. 2) connected to the another network (LAN 135).

Regarding claim 10, Ikeda discloses a data transfer method comprising the steps of:

A) receiving data over a network (receiving data from devices connected to LAN 135, see Fig. 2);

B) determining whether the data should be transferred to a designated recipient based on predetermined delivery conditions and an address of a data transmitter (determined based on communication management information, para. 0036), wherein the network includes LAN and internet (see Fig. 2), the data is an e-mail (para. 0003), and the step B determines that the data should be transferred if the e-mail is received over LAN and that the data should not be transferred if the e-mail is received over the internet (determined based on communication management information, para. 0036) and

C) printing the data when the step B determines that the data should not be transferred (management report is printed when data cannot be managed, para. 0070).

Regarding claim 11, Ikeda discloses a data transfer method of claim 10 further including the step of transferring the data to the designated recipient according to determination made in the step B (recipient determined based on communication management information, para. 0036).

Regarding claim 12, Ikeda discloses a data transfer method of claim 10, wherein the predetermined delivery conditions include day and time of data transfer (see at least para. 0046).

Regarding claim 14, Ikeda discloses a data transfer method of claim 10, wherein the recipient is a printer (printer 206, see Fig. 2) connected to the network (LAN 135).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T. Lett  
AU 2625



KING Y. POON  
PRIMARY EXAMINER